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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,830	12/24/1998	ROBERT W. SISSON	E-826	5561

919 7590 10/14/2004

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EXAMINER

DIXON, THOMAS A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 10/14/2004

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/220,830
Filing Date: December 24, 1998
Appellant(s): SISSON ET AL.

George M. Macdonald
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 August 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

Note: Taylor (4,812,965) and Taylor (GB 2,213,302) are equivalents, both based on application 782,991, the differing citations were an oversight on the examiner's part and have been standardized in the rejection below to refer only to Taylor ('965).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant's arguments do not specifically provide reasons for the groupings, as set forth in 37 CFR 1.192(c)(7) and (c)(8), as to why the claims of group II or III do not stand or fall together with group I except that they depend directly or indirectly from them, there is no reasoning as to patentable distinctness.

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Further, when argued, the dependent claims are not argued as being patentably distinct on their own merits, but that the references are not combinable and is therefore patentable because of its dependence on allegedly allowable base claims.

Further, Argument A is to the combination involving Dolan '980, which is applied only to the dependent claims 2-4, 6-7 and is relied upon for cryptography, claim 2, cryptography with secret key, claim 3, decrypting, claim 4, challenge card is smart card, claim 6, code is electronically retrieved from challenge card and electronically entered into postage meter, claim 7.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,812,400	Eddy et al	9-1998
4,812,965	Taylor	3-1989
5,731,980	Dolan et al	3-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Applicant's arguments that Eddy et al in view of Taylor does not disclose the creation and sending of a card are not convincing .

Eddy discloses the generation of a code associated with the postage meter, see column 17, lines 32-40, and Taylor, Figure 2 (47) clearly discloses the printer (44) at the data center (40) printing a post card for a specific location. Taylor, column 1, lines 26-47 explicitly teaches the motivation for printing a challenge card. The previous rejections are below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 5, 8, 9 are rejected under 35 U.S.C. 103(a) as being anticipated by Eddy et al (5,812,400) in view of Taylor (4,812,965).

As per claim 1, 8, 9.

Eddy et al ('400) discloses:

generating a code at a data center, the code being associated with the postage metering system, see column 17, lines 32 – 40,
retrieving the code from the challenge card and entering the code into the postage metering system subsequent to the receipt of the code at the specific location, see column 17, line 36,
communicating the code retrieved to the data center, see column 3, lines 16-52,
comparing the code received at the data center from the postage metering system to the code generated at the data center to verify that the postage metering system is physically located at the specific location, see column 3, lines 16-52.

Eddy et al ('400) does not specifically disclose:

creating a challenge card, see figure 2 and column 3, lines 16-52,
sending the challenge card via a carrier service to the specific location, see column 3, lines 16-52 for the benefit of cost savings as compared to sending an inspector to the meter.

Taylor ('965) teaches post card inspection:

creating a challenge card, see figure 2 and column 3, lines 16-52,
sending the challenge card via a carrier service to the specific location, see column 3, lines 16-52 for the benefit of cost savings as compared to sending an inspector to the meter.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to create and send a challenge card for inspection for the benefit of cost savings as compared to sending an inspector to the meter.

As per claim 5.

Eddy et al ('400) does not disclose the card is a printed card.

Taylor ('965) teaches a printed post card for inspection, see figure 2 and column 3, lines 16-52,

3. Claims 2-4, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al (5,812,400) in view of Taylor (4,812,965) further in view of Dolan et al (5,731,980).

As per claim 2.

Eddy et al ('400) further discloses the transfer of packed postal codes, see column 18, lines 1-17, and internal and external smart card use, see figure 1 (10, 8, 26).

Eddy et al ('400) does not explicitly disclose the codes are cryptographically secured.

Dolan et al ('980) teaches cryptographic communication between a host and a postage meter, see column 10, lines 6-29, and inspection cards, see column 14, lines 16-30 for the benefit of increased security in a postal metering system.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to cryptographically secure the codes of Eddy et al ('400) within the cryptographic communication taught by Dolan et al ('980) for the benefit of increased security in a postal metering system.

As per claim 3.

Eddy et al ('400) further discloses the transfer of packed postal codes, see column 18, lines 1-17, and internal and external smart card use, see figure 1 (10, 8, 26).

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Eddy et al ('400) does not explicitly disclose the code is cryptographically secured using secret key cryptography.

Dolan et al ('980) teaches multiple types of cryptography in use with postal metering systems, see column 14, line 60 – Column 15, line 33, including digital tokens, RSA and Digital Signatures which use DES encryption, any of which are seen as equivalents to the recited secret key encryption, for the benefit of increased security in a postal metering system.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to cryptographically secure the codes of Eddy et al ('400) with secret key cryptography or any of the cryptographic methods taught by Dolan et al ('980) for the benefit of increased security in a postal metering system.

As per claim 4.

Eddy et al ('400) further discloses the transfer of packed postal codes, see column 18, lines 1-17, and internal and external smart card use, see figure 1 (10, 8, 26).

Eddy et al ('400) does not explicitly disclose the code received from the card is decrypted to verify it's authenticity.

Dolan et al ('980) teaches authenticating digital tokens and multiple types of cryptography in use with postal metering systems, see column 14, line 60 – Column 15, line 33, including digital tokens, RSA and Digital Signatures which use DES encryption, for the benefit of increased security in a postal metering system.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the system of Eddy et al ('400) to decrypt the cryptographically secure codes as taught by Dolan et al ('980) for the benefit of increased security in a postal metering system.

As per claim 6.

Eddy et al ('400) further discloses the transfer of inspection data at refills or zero amount refills, see column 18, lines 58-65, and internal and external smart card use, see figure 1 (10, 8, 26).

Eddy et al ('400) does not explicitly disclose the challenge card is a smart card, but does not preclude use of smart cards.

Dolan et al ('980) teaches internal and external smart cards used in postage meters for refilling, see column 9, line 65 – Column 10, line 29 for the benefit of entering data into and retrieving data from a postage metering system.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Eddy et al ('400) to use the external smart cards taught by Dolan et al ('980) for the benefit of increased user convenience.

As per claim 7.

Eddy et al ('400) does not explicitly disclose the code is electronically entered from the card.

Dolan et al ('980) teaches internal and external smart cards used in postage meters and communication between the cards and the meters, see column 9, line 65 – Column 10, line 29 for the benefit of entering data into and retrieving data from a postage metering system.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Eddy et al ('400) to communicate the code electronically from the external smart cards taught by Dolan et al ('980) for the benefit of increased user convenience in not having to enter the code manually.

(11) Response to Argument

When argued, the dependent claims are not argued as being patentably distinct on their own merits, but that the element is not taught and is therefore patentable because of its dependence on allegedly allowable base claims.

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A) Argument A is to the combination involving Dolan '980, which is applied only to the dependent claims 2-4, 6-7 and is relied upon for cryptography, claim 2, cryptography with secret key, claim 3, decrypting, claim 4, challenge card is smart card, claim 6, code is electronically retrieved from challenge card and electronically entered into postage meter, claim 7.

B) Argument B is to independent claim 1 and dependent claims 6-7, but argues claims 1,5, 8-9 and implies that the motivation must be suggested by the prior art,

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation comes from the knowledge of one of ordinary skill in the art.

C) Argument C is to dependent claims 2-4, but argues that the primary reference does not disclose cryptography, a feature that Dolan is relied upon for, as seen above.

However, Eddy et al ('400) does disclose use of cryptography for self-authentication, see column 9, lines 61-67.

D) Argument D is to dependent claims 6-7, but argues that the primary reference does not disclose that the challenge card is a smart card, floppy diskette or CD-ROM, a feature that Dolan is relied upon for, as seen above.

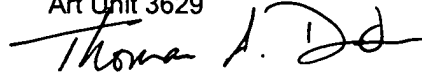
However, Eddy et al ('400) does disclose the use of smart cards, both internal to and external to, the postage meter, see figure 1 (76, 78, and 80) and column 9, lines 53-58, it is seen that Eddy et al ('400) would not preclude the use of a challenge card that was a smart card.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


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Primary Examiner
Art Unit 3629



October 8, 2004

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10-12-04

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